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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/866,765
Filing Date: May 30, 2001
Appellant(s): HODGE ET AL.

Jon M. Isaacson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5 June 2009 appealing from the Office action mailed 4 September 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,903,816	Broadwin et al.	5-1999
6,219,837	Yeo et al.	4-2001
6,339,842	Fernandez et al.	1-2002
6,922,843	Herrington et al.	7-2005
2001/0024469	Keren et al.	9-2001
2002/0073416	Ramsey Catan	6-2002
5,490,060	Malec et al.	2-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 44-48, 51-57, 60-67, 69-70, 77-82, 84-85, 92-96, 99-106 and 108-109 are rejected under 35 U.S.C. 102(b) as being anticipated by Broadwin (of record).

Regarding claims 44, 53, 62, 77, 92 and 101, Broadwin discloses a method, comprising:

receiving an electronic file (interactive application content, see col 5, lines 2-10), wherein the electronic file includes an interactive icon (see selections options, see col 7, lines 34-41) and first content (see col 5, lines 2-10),

receiving a video signal including second content (audiovisual content, see col 4, lines 57-63),

generating instructions for a set-top box (see col 5, lines 1-10), wherein the instructions for the set-top box are configured to overlay the interactive icon (see selections options, see col 7, lines 34-41) in the electronic file (interactive application content, see col 5, lines 2-10) on at least a portion of the second content (audiovisual content, see col 4, lines 57-63) in the video signal (see col 7, lines 28-41) and the instructions for the set-top box are configured to display the first content if the interactive icon is selected (see col 7, lines 48-53),

combining the video signal, the instructions for the set-top box, and the electronic file together to form a first channel (interactive channel, see col 5, lines 11-14),

combining the first channel with a second channel (non-interactive channel) to form a broadcast signal, and transmitting the broadcast signal to the set-top box (see col 5, lines 17-23).

Regarding claims 45, 54, 63, 78, 93 and 102, Broadwin discloses receiving an audio signal associated with a video signal (see col 4, lines 56-59), and

combining the audio signal, the video signal, instructions for a set-top box, and an electronic file together to form a first channel (see col 5, lines 11-14).

Regarding claims 46, 55, 64, 79, 94 and 103, Broadwin discloses first content in an electronic file comprises graphics and text (see col 7, lines 28-41).

Regarding claims 47, 56, 65, 80, 95 and 104, Broadwin discloses a video signal depicting a product (advertising, see col 6, lines 43-46).

Regarding claims 48, 57, 66-67, 81-82, 96 and 105-106, Broadwin discloses wherein the first content includes a purchasing screen for purchasing the product on at least a portion of the second content in the video signal (see col 7, lines 39-41 and lines 51-53).

Regarding claim 51, 60, 69, 84, 99 and 108, Broadwin discloses an electronic file including a catalog of products, and set-top box instructions configured to overlay the catalog of products on at least a portion of a second content in a video signal (see col 9, lines 21-30 and Fig. 15).

Regarding claims 52, 61, 70, 85, 100 and 109, Broadwin discloses an electronic file including an advertisement, and set-top box instructions configured to overlay the advertisement on at least a portion of a second content in a video signal (see col 9, lines 45-51 and Fig. 15).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 49, 58, 68, 83, 97 and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (of record), as applied to claims 44, 53, 62 and 77 above, and further in view of Yeo (of record).

Regarding claims 49, 58, 68, 83, 97 and 107, Broadwin does not specifically disclose a video signal including a primary video component and a secondary video component, wherein the primary video component comprises a moving video image and the secondary video component comprises a static video image.

In an analogous art, Yeo discloses a video signal including a primary video component (see col 3, lines 18-19) and a secondary video component (see col 3, lines 25-27), wherein the primary video component comprises a moving video image (see col 3, lines 18-19) and the secondary video component comprises a static video image (see col 3, lines 25-27).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Broadwin's system to include a video signal including a

primary video component and a secondary video component, wherein the primary video component comprises a moving video image and the secondary video component comprises a static video image, As disclosed by Yeo, for the advantage of allowing a viewer to view a video summary of a one program while simultaneously watching another.

5. Claims 50, 59, 71, 86, 98 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (of record) and Yeo (of record), as applied to claims 49, 58, 68 and 83 above, and further in view of Fernandez (of record).

Regarding claims 50, 59, 71, 86, 98 and 110, Broadwin in view of Yeo discloses an electronic file including information (see Broadwin, col 5, lines 6-9), and instructions for a set-top box configured to overlay the information on a static video image (see col 9, lines 21-30 and Fig. 15).

Broadwin in view of Yeo does not specifically disclose an electronic file including information about a current event.

In an analogous art, Fernandez discloses an electronic file including information about a current event (see col 2, lines 16-22).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the system of Broadwin in view of Yeo to include electronic file including information about a current event, as disclosed by Fernandez, for the advantage of allowing a viewer to view news updates while watching a program.

6. Claims 72, 87 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (of record), as applied to claims 67 and 81 above, and further in view of Herrington of record).

Regarding claims 72, 87 and 111, Broadwin discloses generating a signal to overlay an interactive advertisement over at least a portion of a second content in a video signal (see col 7, lines 28-31), but does not specifically disclose receiving a customer I.D. number associated with a permission level,

comparing the permission level associated with the customer I.D. number to a permission level associated with the advertisement stored in the electronic file, and

displaying the advertisement when the permission level associated with the customer I.D. is greater than the permission level associated with the advertisement stored in the electronic file.

In an analogous art, Herrington discloses receiving a customer I.D. number associated with a permission level (see col 21, lines 7-10),

comparing the permission level associated with the customer I.D. number to a permission level associated with the advertisement stored in the electronic file (see col 21, lines 10-12), and

displaying the advertisement when the permission level associated with the customer I.D. is greater than the permission level associated with the advertisement stored in the electronic file (see col 21, lines 10-12).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Broadwin's system to include receiving a customer I.D. number associated with a permission level, comparing the permission level associated with the customer I.D. number to a permission level associated with the advertisement stored in the electronic file, and displaying the advertisement when the permission level associated with the customer I.D, as disclosed by Herrington, for the advantage of providing a level of control for children's viewing habits.

7. Claims 73, 88 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (of record), as applied to claims 67 and 81 above, and further in view of Keren (of record).

Regarding claims 73, 88 and 112, Broadwin discloses generating a signal to overlay an interactive advertisement on at least a portion of a second content in a video signal (see col 7, lines 28-31), but does not specifically disclose overlaying for a predetermined time period, or

generating a signal to overlay a second interactive advertisement on at least a portion of the second content in the video signal after the predetermined time period has elapsed.

In an analogous art, Keren discloses overlaying for a predetermined time period (see [0406], lines 1-5), and generating a signal to overlay a second interactive

advertisement on at least a portion of the second content in the video signal after the predetermined time period has elapsed (see [0406], lines 6-9).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Broadwin's system to include overlaying for a predetermined time period, or generating a signal to overlay a second interactive advertisement on at least a portion of the second content in the video signal after the predetermined time period has elapsed, as disclosed by Keren, for the advantage of ensuring that a viewer has adequate time to view and advertisement.

8. Claims 74-75, 89-90 and 113-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (of record), as applied to claims 67 and 81 above, and further in view of Ramsey Catan (of record).

Regarding claims 74-75, 89-90 and 113-114, Broadwin discloses outputting a composite signal, wherein the composite signal includes an interactive purchasing screen for a product (see col 9, lines 45-51 and Fig. 15).

Broadwin does not specifically disclose receiving a signal to purchase a product,

receiving a customer ID number associated with a permission level,

determining, by a set top box, if the permission level associated with the customer ID number is greater than a permission level associated with the product, and

authorizing, by the set top box, the purchase of the product when the permission level associated with the customer ID is greater than the permission level associated with the product.

In an analogous art, Ramsey Catan discloses receiving a signal to purchase a product (see [0017], line 3,

receiving a customer ID number (see [0017], lines 4-6) associated with a permission level (see 0017], lines 6-8),

determining, by a set top box, if the permission level associated with the customer ID number (the credit limit allotted to the customer) is greater than a permission level associated with the product (the price of the product) see [0018], lines 12-18), and

authorizing, by the set top box, the purchase of the product when the permission level associated with the customer ID is greater than the permission level associated with the product (see [0018], 12-18).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Broadwin's system to include receiving a signal to purchase a product, receiving a customer ID number associated with a permission level, determining, by a set top box, if the permission level associated with the customer ID number is greater than a permission level associated with the product, and authorizing, by the set top box, the purchase of the product when the permission level associated with the customer ID is greater than the permission level associated with the product, as disclosed by Ramsey Catan, for the advantage of allowing a parent to provide access

for a child to a credit card without providing the full access to the entire limit of the credit card.

9. Claims 76, 91 and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin (of record) in view of Ramsey Catan (of record), as applied to claims 75 and 90 above, and further in view of Malec (of record).

Regarding claims 76, 91 and 115, Broadwin in view of Ramsey Catan discloses storing information indicative of a purchase of a product in a set-top box (see [0045], lines 4-7), but does not specifically disclose storing information indicative of the purchase of the product in a purchase buffer, or connecting to an e-commerce server to transfer the information indicative of the purchase of the product to the e-commerce server.

In an analogous art, Malec discloses storing information indicative of the purchase of the product in a purchase buffer (see claim 32, lines 14-16), and connecting to an e-commerce server to transfer the information indicative of the purchase of the product to the e-commerce server (see claim 32).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the system of Broadwin in view of Ramsey Catan to include storing information indicative of the purchase of the product in a purchase buffer, or connecting to an e-commerce server to transfer the information indicative of the purchase of the product to the e-commerce server, as disclosed by Malec, for the

advantage of controlling the rate of data transfer when transferring purchase records from a set top box to a server.

(10) Response to Argument

Claim 44

In response to appellant's argument (Page 8, 2nd ¶) stating Broadwin fails to teach generating instructions for a set-top box to overlay the received interactive icon on at least a portion of the received second content and to display the received first content if the interactive icon is selected, the examiner respectfully disagrees.

Broadwin discloses application server 104 generates interactive application content which comprises application code or "instructions" (Col. 5, lines 1-6). The application code or "instructions" is to be executed by the processor within a set-top box to execute the received interactive application (Col. 5, lines 1-6). Further, Broadwin discloses CPU 314 of decoder 140 uses the received application code or "instructions" to cause one or more selection buttons or "interactive icons" to be overlaid on top of a television program or "second content" (Col. 7, lines 34-41 and Col. 6, lines 54-65). Further, if the user selects a selection button or "interactive icon", decoder 140 displays the linked still image to the user (Col. 7, lines 46-53 and Col. 2, lines 48-67). From the disclosure, Broadwin clearly teaches the processor within decoder 140 uses the received application data to facilitate overlaying the selection buttons or "interactive icons" on the received audiovisual content or "second content". Further Broadwin

discloses in response to the selection of a selection button or "interactive icon" a linked still image or "first content" is displayed in response to the user's selection of the button.

Thus, Broadwin teaches the limitation of generating instructions (i.e., generating application code by application server 104; Col. 5, lines 1-6) for a set-top box (i.e., decoder 140), wherein the instructions for the set-top box configure the set-top box to overlay the interactive icon (i.e., selection buttons) in the electronic file on at least a portion of the second content (i.e., selection buttons are overlaid on top of the displayed audio/video output) in the video signal and the instructions for the set-top box configure the set-top box to display the first content (i.e., linked still image) if the interactive icon is selected (Col. 5, lines 1-6 and Col. 7, lines 20-53).

In response to appellant's argument (Page 9, 2nd ¶) stating Broadwin fails to expressly teach receiving an electronic file, wherein the electronic file includes an interactive icon and first content and generating instructions for the received interactive icon in the electronic file, the examiner respectfully disagrees.

Broadwin discloses application server 104 for generating interactive application content or providing interactive applications (Col. 5, lines 1-10). Based on the cited disclosure, application server 104 may provide or make available interactive program applications or "electronic files" to subscribers such that it would be a prerequisite for application server 104 to receive beforehand the interactive program applications or "electronic files" from a source, such as an advertiser or vendor, in order to facilitate distributing interactive applications that enables the user to order a product or to provide

an indication that the user desires to receive more information (Col. 2, lines 48-67 and Col. 3, lines 36-55). Broadwin discloses subscribers may interact with the program they are currently viewing to order a product (Col. 7, lines 42-65 and Col. 6, lines 22-38). Typically the advertiser or vendor of the product will provide the interactive content directly to a broadcaster to facilitate generating new business and increased sales of the product. A broadcast server such as application server 104 will package the received content and generate application code or "instructions" that will be included in the broadcast signal that will facilitate the display of the received interactive application or "electronic file" using the subscriber's decoder (Col. 5, lines 1-65).

Accordingly, Broadwin discloses receiving an electronic file (i.e., application server 104 receives interactive applications from a source such as a third party; Col. 5, lines 1-10), wherein the electronic file (i.e., interactive application content; Col. 5, lines 1-10) includes an interactive icon (i.e., selection buttons) and first content (i.e., linked still images) (Col. 7, lines 25-53) and generating instructions (i.e., generating application code by application server 104; Col. 5, lines 1-6) for a set-top box (i.e., decoder 140), wherein the instructions for the set-top box configure the set-top box to overlay the interactive icon (i.e., selection buttons) in the electronic file on at least a portion of the second content (i.e., selection buttons are overlaid on top of the displayed audio/video output) in the video signal and the instructions for the set-top box configure the set-top box to display the first content (i.e., linked still image) if the interactive icon is selected (Col. 5, lines 1-6 and Col. 7, lines 20-53).

In response to appellant's argument (Page 11, 1st ¶) stating Broadwin teaches away from generating instructions for a set-top box based on received first content, the examiner respectfully disagrees.

Broadwin discloses application server 104 can be used to provide interactive applications and interactive program content (Col. 5, lines 1-10). Based on the cited disclosure, application server 104 may provide or make available interactive program applications or "electronic files" to subscribers such that it would be a prerequisite for application server 104 to receive beforehand the interactive program applications or "electronic files" from a source, such as a third party provider or a network studio, in order to facilitate distributing interactive applications that facilitates the sale of goods to subscribers or facilitate interactive with the program via the subscriber's decoders (Col. 5, lines 32-37; Col. 6, lines 8-38 and Col. 7, lines 42-53).

Claim 48

In response to appellant's argument, (Page 12, 4th ¶) stating Broadwin fails to disclose wherein the first content includes a purchasing screen for purchasing the product on at least a portion of the second content in a video signal, the examiner respectfully disagrees.

Broadwin discloses when the television is displaying video content from an AVI signal which includes interactive program content, the interactive program content is executed by the set top box or interactive decoder to display various selection options on the television. One or more of the selection options each corresponds to respective

compressed still video images broadcast on the still image channel. The user or viewer can select one of the options to view desired information. When the set top box receives user input selecting an option to view one of the linked still images, the set top box captures the requested image from the still image broadcast channel, stores the image in memory, and displays the captured still video image corresponding to the selection. The still image being displayed may have associated interactive program content for displaying further selections, wherein these selections may be for viewing other images or content, for ordering information, or purchasing products. The user can thus selectively navigate between the video content and stills in a web-like hyperlinked fashion (Col. 2, lines 48-67). Broadwin further discloses overlaying selection buttons or "interactive icons" over the audiovisual program and in response to a user selecting a button, displaying a linked still image that enables a user to order a product.

Thus, Broadwin teaches the limitation of wherein the first content (i.e., linked still image) includes a purchasing screen for purchasing the product (i.e., user is provided opportunity to order a product using the displayed linked still image) on at least a portion of the second content in a video signal (i.e., the linked still image is downloaded and displayed in memory of the decoder and the user can navigate back and forth between the order product screen and video program) (Col. 7, lines 34-65 and Col. 2, lines 48-67).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/CHRIS PARRY/

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